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**Date:** June 19, 2003**To:** Benjamin A. Pezzlo, Examiner  
U.S. Patent & Trademark Office**Fax #:** 703-308-3519**From:** Nancy T. Krawczyk  
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**Message:****Re:** Serial No. 10/009,695 ✓  
Filed: November 6, 2001  
DN1999119USA

Transmitted herewith is a Response After Final.

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GROUP 3600

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6/24/03

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mark Guy Trowbridge )  
 For: AIR SPRING UPPER )  
 RETAINER )  
 Serial No. 10/009,695 )  
 Filed: November 6, 2001 )

Confirmation No. 1290

Docket No. DN1999119USA

Art Unit: 3683

Examiner: Benjamin A. Pezzlo

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Nancy T. Krawczyk

(Name of Registered Representative)

(Signature)

(Date of Signature)

June 19, 2003

## RESPONSE AFTER FINAL

Dear Sir:

In response to the June 9, 2003 Office Action, the following remarks are set forth.

35 U.S.C. § 102

Claims 1, 3, and 4 have been rejected under 35 U.S.C. § 102(e) as anticipated by Koeske et al (US 6,250,613). This rejection is respectfully traversed for the following reasons.

In order for a reference to fully anticipate a claim under 35 U.S.C. § 102, the reference **must** disclose **each** and **every** element of the claimed invention.

Despite the assertion otherwise in the Office Action, it cannot be stated forcefully enough - Koeske does NOT show each and every element of the claimed invention as Koeske fails to teach or disclose showing a retainer having an integrally formed ribbed structure as recited.

The sole alleged support for this interpretation of Koeske is that Koeske states that the "invention relates to a non-metallic spacer for the piston or bead plate of an air spring assembly." Thus Koeske does teach that the spacer structure may be applied to either the top or the bottom of the air spring assembly. Given that the primary goal of Koeske is to provide a separate, distinct, and individual spacer to be used in combination with the air spring assembly, the above quoted statement fails to teach that the spacer is integrally formed with

the bead plate as asserted in the rejection.

Furthermore, to assert that Koeske is a 102 reference against a claim that recites an "integrally formed intermediate structure," language that is repeated in the rejection of the claim, directly contradicts the later statement in paragraph 6 of the Office Action of "Koeske et al. fail to disclose the retainer being formed as a unitary article."

Koeske cannot have a particular feature in a 102 rejection and then fail to have to same feature in a 103 rejection.

In response to Applicants arguments file May 5, 2003, it is stated that in regard to claim 1 that "the feature upon which the applicant relies (i.e. the retainer being integrally formed with the intermediate ribbed reinforcement structure) are not recited in the rejected claim(s)." Applicant directs the examiner's attention to the May 5<sup>th</sup> amendment of claim 1 wherein the language "integrally formed" was inserted so that the claim recites that the air spring retainer has "an integrally formed intermediate ribbed reinforcement structure." If this fails to recite what Applicant is arguing, than the examiner is splitting hairs over the word "having" (it noted that the word 'having' is used solely because it is the proper verb tense for the Jepson style claim) versus the word 'being' and it is requested that the examiner propose language for claim 1 that he feels would make it evident what Applicant is claiming.

It is respectfully requested that this rejection be withdrawn.

### 35 U.S.C. § 103

Claims 5-6 stand been rejected under 35 U.S.C. § 103(a) as being unpatentable over Koeske et al. This rejection is respectfully traversed for the following reasons.

Claim 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Koeske et al. in view of Geno et al. (US 4,946,144). This rejection is respectfully traversed for the following reasons.

Both of these rejections are based upon the 102 rejection of claim 1 as anticipated by Koeske et al. As argued above, Koeske et al fails to anticipate claim 1, as Koeske fails to disclose each and every element of claim 1. The rejections of the dependent claims fails to make up for this deficiency.

Claims 9-11 and 2 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Koeske et al.

Again, *In re Larson* is applied to assert that it is an obvious engineering choice to

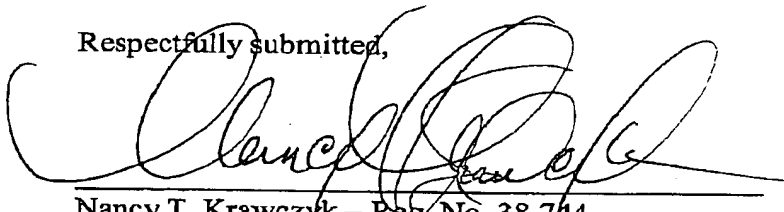
provide a one-piece construction. This rejection is respectfully traversed for the same reason set forth in the May 5<sup>th</sup> response, which are incorporated herein by reference thereto.

To convert the spacers into an integral part of the air spring retainer, as asserted in the Office Action, would remove the taught benefits, and the primary inventive goal of Koeske, of having a separate spacer, and is contrary to the expressed goals of Koeske. 'We have noted elsewhere, as a "useful general rule," that references that teach away cannot serve to create a *prima facie* case of obviousness. *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q. 1131, 1132 (Fed. Cir. 1994). In the context of *in re Gurley*, Koeske specifically teaches the necessity to have separate elements while *in re Larson* teaches forming a unitary article, thus they cannot be combined. Koeske specifically teaches away from forming the spacer and any part of the air spring as a unitary article. These teachings cannot be ignored.

This argument was held unpersuasive because making the retainer unitary "provides benefits independently of those lost by making the ribbed reinforcement structure separate from the retainer." This statement indicates that every explicit teaching of Koeske is going to be ignored in an attempt to reject Applicants claims. Furthermore, there is no indication of what these other independent benefits are. What are these independent benefits that are so terrific that it is worth completely ignoring all of the teachings of Koeske? Absent any teaching or showing of what these independent benefits are, this rejection is based solely on impermissible hindsight made in a desperate attempt to obviate Applicant's claims.

It is requested that the arguments previously presented be reconsidered and this rejection be withdrawn as the Examiner has failed to carry his burden of establishing a *prima facie* case of obviousness.

Respectfully submitted,



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